THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 13

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte GREGORY J. RAJALA, GERALD L. RABE, PAUL M. NIEMI and DONALD J. HOLEWINSKI

Appeal No. 97-3065
Application No. 08/452,747[1]

ON BRIEF

Before MEISTER, McQUADE, and NASE, Administrative Patent Judges.

NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 68, 70, 71, 73 to 76, 79, 83 and 96 to 98, which are all of the claims pending in this application.[2]

[1] Application for patent filed May 30, 1995. According to the appellants, the application is a division of Application No. 08/382,109, filed January 31, 1995, now U.S. Patent No. 5,552,007.

[2] Independent claim 68 and dependent claim 70 were amended subsequent to the final rejection. As a result of those

We REVERSE and enter new rejections pursuant to 37 CFR § 1.196(b).

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amendments, the examiner withdrew the rejection under 35 U.S.C. § 112, second paragraph.

BACKGROUND

The appellants' invention relates to an apparatus for transporting a continuous web. An understanding of the invention can be derived from a reading of exemplary claim 68, which appears in the appendix to the appellants' brief.

The prior art reference of record relied upon by the examiner in rejecting the appealed claims is:

Beaudoin et al. (Beaudoin) 4,925,520 May 15, 1990

An additional reference of record relied on by this panel of the Board is:[3]

On Site Technical Data Sheet: 900 Release/Traction Series, Plasma Coatings, Inc. (Plasma)

Reference made of record by this panel of the Board is:

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[3] This reference was cited by the appellants in their Information Disclosure Statement (Paper No. 3) and a copy is of record in the application file. While this reference is undated, we take the appellants submission of the reference and their discussion of coatings from Plasma Coatings Inc. (specification, page 12, lines 30-36) as an admission that the reference is prior art to their invention.

Ales et al. (Ales) 4,726,873 Feb. 23, 1988

Claims 68, 70, 71, 73 to 76, 79, 83 and 96 to 98 stand rejected under 35 U.S.C. § 103 as being unpatentable over Beaudoin.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejection, we make reference to the examiner's answer (Paper No. 12, mailed March 31, 1997) for the examiner's complete reasoning in support of the rejection, and to the appellants' brief (Paper No. 11, filed March 3, 1997) for the appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art reference, and to the respective positions articulated by the appellants and the examiner. Upon evaluation of all the evidence before us, it

is our conclusion that the evidence adduced by the examiner is insufficient to establish a prima facie case of obviousness with respect to the claims under appeal. Accordingly, we will not sustain the examiner's rejection of claims 68, 70, 71, 73 to 76, 79, 83 and 96 to 98 under 35 U.S.C. § 103. Our reasoning for this determination follows.

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A prima facie case of obviousness is established by presenting evidence that the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the references before him to make the proposed combination or other modification. See In re Lintner, 9 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972). Furthermore, the conclusion that the claimed subject matter is prima facie obvious must be supported by evidence, as shown by some objective teaching in the prior art or by knowledge generally available to one of ordinary skill in the art that would have led that individual

to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Rejections based on § 103 must rest on a factual basis with these facts being interpreted without hindsight reconstruction of the invention from the prior art. The examiner may not, because of doubt that the invention is patentable, resort to speculation, unfounded assumption or hindsight reconstruction to supply deficiencies in the factual basis for the rejection. See In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 177 (CCPA 1967), cert. denied, 389 U.S. 1057 (1968).

With this as background, we analyze the prior art applied by the examiner in the rejection of the claims on appeal.

Beaudoin discloses an apparatus for applying an elastic waistband transversely of a longitudinally moving web. Figure 3 shows the general arrangement of the parts of the apparatus for
applying elastic waistbands transversely of a moving web. The principal components of the elastic waistband applicator are a

vacuum roll or drum 20, an elastic segment transfer device 21, a backup member in the form of an elastomer coated transfer roll 22, a segment pressing element 23 and a knife roll 24 near the top of the drawing. A ribbon of elastic material 14A is fed onto the periphery of vacuum drum 20. The knife roll 24 rotates with the periphery of vacuum drum 20 and uses the drum as an anvil for cutting individual segments 14 from elastic ribbon 14A. The segments are carried rotationally on vacuum drum 20 until they reach a lowermost position where they are picked off of the vacuum drum 20 by segment transfer means 21 which stretches the segments and transfers them to sheet 13 which runs over transfer roll 22 which serves as a backup member for the sheet or web when an elastic ribbon segment is being pressed onto it. Roll 22 is provided with a silicone rubber cylindrical sleeve 35 which inhibits slipping between sheet 13 and the roll 22 and provides resiliency for pressing the segment on the sheet.

Figures 11-13 show another implementation of the stretch-while-rotating concept in which the elastic segment stretching and transferring device 21 is shown isolated from

the diaper fabricating machine but it will be understood that it will be positioned between vacuum drum 20 and sheet 13 which overlays backup roll 22 as previously described with respect to Figure 3. Referring to Figure 11, the transfer device comprises a rotor generally designated by the numeral 125. A pair of grippers 126 and 127 are mounted in rotor 125. Gripper 126 is fixed in the rotor. Gripper 127 is slidable axially. As shown in Figure 13, there is another pair of grippers 128 and 129 diametrically opposite on the rotor from grippers 126 and 127. Gripper 128 is fixed in the rotor and gripper 129 is reciprocable axially relative to fixed gripper 128. The grippers are provided with a plurality of vacuum ports 130 and 136. The grippers have a plurality of rather sharp elements such as pins 132 and 138 adjacent the vacuum ports to supplement the gripping force on the elastic segment which force is created by the vacuum ports. The operation of the transfer device of Figures 11-13 will now be briefly described. In Figure 13, the rotor is at a rotational position wherein stationary gripper 126 and its cooperating movable gripper 127 are both engaged with an unstretched elastic segment and are about to strip the segment 14 from

vacuum drum 20 due to rotation of the rotor. As the rotor continues to rotate, the gripper 127 is separated from gripper 126 causing the elastic segment 14 to be stretched. When the grippers arrive in the
position in which grippers 128 and 129 are presently shown, elastic segment 14 is stretched to its desired limit and is overlaying sheet 13 to which it is applied by the grippers.

Claim 68 recites an apparatus for transporting a continuous web comprising, inter alia, a first rotary transport device and a second rotary transport device disposed in working relationship with the first rotary transport device. The first rotary transport device has a first outer working surface having a first set of protuberances thereon. The second rotary transport device has a second outer working surface having a second set of protuberances thereon. The first and second outer working surfaces are aligned with each other at a locust of closest approach.

The examiner determined (answer, page 4) that

> [c]laims 68, 70, 71, 73-76, 79, 83, and 96-98 differ from Beaudoin et al in that the claims set forth the use of two rotary transport devices in order to convey the elastic web. Beaudoin et al teach the conveyance of an elastic web via two rotary transport devices, one of which comprising the limitations of the rotary transport device as set forth in claim 68.

The examiner then concluded (answer, page 5) that

> [i]t would have been obvious to one of ordinary skill in the art to replace the vacuum drum with another transport device (125) as taught by Beaudoin et al, in order to engage the elastic web on both sides to ensure that the web width tension is maintained as it travels from one roller to another.

The appellants argue (brief, pages 7-9) that Beaudoin does not teach or suggest the claimed invention and that the examiner has used impermissible hindsight to derive the claimed invention. We agree. We see no motivation in the applied prior art of why one skilled in the art would have modified the device of Beaudoin to make the modifications necessary to arrive at the claimed invention. There is no need for the vacuum drum 20 of Beaudoin to have thereon a means for stretching the segments 14 as in his rotor 125 since the segments on vacuum drum 20 are maintained in an unstretched state. Thus, the examiner has failed to meet the

initial burden of presenting a prima facie case of obviousness.[4] Thus, we cannot sustain the examiner's rejection of claims 68, 70, 71, 73 to 76, 79, 83 and 96 to 98 under 35 U.S.C. § 103.[5]

New grounds of rejection

Under the provisions of 37 CFR § 1.196(b), we enter the following new grounds of rejection.

35 U.S.C. § 112, first paragraph

Claim 98 is rejected under 35 U.S.C. § 112, first paragraph, as the specification, as originally filed, does not provide support for the invention as is now claimed.

The test for determining compliance with the written description requirement is whether the disclosure of the application as originally filed reasonably conveys to the artisan that the inventor had possession at that time of the

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[4] Note In re Rijckaert, supra; In re Lintner, supra; and In re Fine, supra.

[5] In re Fine, supra; In re Warner, supra.

later claimed subject matter, rather than the presence or absence of literal support in the specification for the claim language. See Vas-Cath, Inc. v. Mahurkar, 935 F.2d 1555, 1563-64, 19 USPQ2d 1111, 1116-17 (Fed. Cir. 1991) and In re Kaslow, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983).

Claim 98 recites that "said first and second substrate is primarily a metallic coating applied to said first and second rotary transport devices using a high temperature application process."

The original disclosure provides no description as to the composition of the substrate 44. However, the original disclosure does describe (page 12, lines 30-33) that the coating 48 is applied as a generally metallic composition, by plasma or other high temperature application process. Thus, the disclosure of the application as originally filed would not have reasonably conveyed to the artisan that the inventor had possession at that time of the later claimed subject matter (i.e., that the "substrate" is primarily a metallic

coating applied to the first and second rotary transport devices using a high temperature application process).[6]

35 U.S.C. § 103

Claims 68, 70, 71, 73 to 76, 79, 83 and 96 to 98[7] are rejected under 35 U.S.C. § 103 as being unpatentable over Ales in view of Plasma.

The test for obviousness is what the combined teachings of the references would have suggested to one of ordinary skill in the art. See In re Young, 927 F.2d 588, 591, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991) and In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). Moreover, in evaluating such references it is proper to take into account not only the specific teachings of the references but also the inferences which one skilled in the art would reasonably be

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[6] This rejection would be overcome by amending "substrate is" in claim 98 to be --outer working surfaces are--.

[7] Claim 98 has been included in this rejection based upon our belief that the appellants will amend claim 98 as proposed above to overcome the 35 U.S.C. § 112, first paragraph, rejection.

expected to draw therefrom. In re Preda, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968).

Ales discloses an apparatus for applying contoured elastic to a substrate. The operation of the apparatus 70 will be described with reference to Figures 4, 5 and 6. A backing sheet for a garment is supplied from source 76 as sheet 100. Sheet 100 is fed to the forming drum 102. Forming drum 102 is preferably provided with a vacuum source such that the web 100 is securely adhered thereto by the vacuum being drawn through a series of holes in the outer surface 104 of the drum. Instead
of vacuum, Ales teaches that it is possible to hold the web in place by needles piercing the material at the edge or by a tenter frame. The web 100 adhered to drum 102 then passes beneath the first pin applicator roll 78 to which is fed in a straight line two strips of stretched self-adhering elastic 106 and 108. These strips of elastic are applied to the rim 78 below rollers 110 and 112 and are formed in rings around pins 114 by cutting and adhering devices 116 and 118. When the rings of elastic 120

pass through the nip 122 the pins 114 are retracted, and the elastic 120 is adhered to web 100. The web 100 bearing ring 120 is then moved as drum 102 rotates beneath the second pin drum roll 80. In a similar manner pin drum roll 80 applies two strips of self-adhering elastic 124 and 126 to the drum 80 where it is applied around pins 128 with sealing together of the strips 124 and 126 by the nipping/cutting apparatus 130 and 132. Rings of elastic 134 are formed which at nip 136 are transferred to sheet 100. The rotation of the product-forming drum 102 then brings the web bearing the double ring of elastics 134 and 120 to the point of application of sheet 90 that covers the exposed self-adhering elastic so that the web may be handled. The composite then is formed as the sheet 90 is adhered to the exposed elastic adhesives by contoured pressure rollers 148 and 150. The elasticized composite is removed by being drawn over roller 152 and brought to the die cutters 192 composed of rolls 154 and 156. These cutting rolls remove the portion within elastic loops or bands 120 and 134 to leave hole 158. The composite then may be cut into blanks for immediate conversion to articles or may be rolled for later conversion.

Plasma discloses a coating material that provides wear resistance, excellent release and excellent web tracking properties. Plasma teaches that their coating is used to replace "cured fluorocarbons, silicone coatings/tapes, Teflon® tape/sleeve, rubber coverings and chrome plating." Plasma also discloses that their coating can be applied to laminator rolls, oven rolls and idler rolls.

After the scope and content of the prior art are determined, the differences between the prior art and the claims at issue are to be ascertained. Graham v. John Deere Co., 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966).

Based on our analysis and review of Ales and the claims under appeal, it is our opinion that the only difference is that the outer working surfaces of drum 102 and roller 152 do not have the claimed protuberances thereon.

In our opinion, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have coated the outer working surfaces of drum 102 and

roller 152 of Ales with a coating as taught by Plasma to provide wear resistance, excellent release and excellent web tracking properties. We note that while Plasma does not specifically set forth that the coatings provide protuberances (claim 68), the release agent (claims 70, 71, 73 and 96), or that the coating is metallic (claim 98), it is our view based upon the appellants' admissions made on pages 12-13 of the specification, that these limitations are inherently met by the coatings disclosed by Plasma. With regard to the claimed amount of shrinkage permitted (claims 75, 76 and 79, it is our determination that such limitations are also inherently met by the above-noted modification of Ales.

CONCLUSION

To summarize, the decision of the examiner to reject claims 68, 70, 71, 73 to 76, 79, 83 and 96 to 98 under 35 U.S.C. § 103 is reversed and new rejections of claim 98 under 35 U.S.C. § 112, first paragraph, and claims 68, 70, 71, 73 to 76, 79, 83 and 96 to 98 under 35 U.S.C. § 103 have been added pursuant to provisions of 37 CFR § 1.196(b).

This decision contains new grounds of rejection pursuant to 37 CFR § 1.196(b)(amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53131, 53197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. Office 63, 122 (Oct. 21, 1997)). 37 CFR § 1.196(b) provides that, "A new ground of rejection shall not be considered final for purposes of judicial review."

37 CFR § 1.196(b) also provides that the appellants, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new grounds of rejection to avoid termination of proceedings (§ 1.197(c)) as to the rejected claims:

> (1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .
>
> (2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

REVERSED; 37 CFR § 1.196(b)

JAMES M. MEISTER Administrative Patent Judge	)
JOHN P. McQUADE Administrative Patent Judge	) BOARD OF PATENT APPEALS AND INTERFERENCES
JEFFREY V. NASE Administrative Patent Judge	)

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APPLICATION NO. 08/452,747

APJ NASE

APJ McQUADE

APJ MEISTER

DECISION: **REVERSED;**
37 CFR § 1.196(b)

Prepared By: Delores A. Lowe

DRAFT TYPED: 09 Jun 98

FINAL TYPED: